

### Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The final Office Action dated January 8, 2004, indicated that claims 1-31 are rejected under 35 U.S.C. § 102(e) over *Duluk, Jr. et al.* (U.S. Patent No. 6,288,730).

Applicant maintains the traversal of the Section 102(e) rejection presented in the previous October 15<sup>th</sup> Office Action Response and Amendment because the relied upon portions of the '730 reference are not prior art with respect to the claimed invention. As explained previously, the instant application appropriately claims the benefit of an underlying provisional application filing date which predates the filing date of the '730 reference. However, the Examiner improperly asserts the Section 102(e) rejection by relying upon an underlying provisional filing date as the effective filing date for the '730 reference.

The Section 102(e) rejection is improper because the Examiner has not provided evidence of the requisite support to rely on the underlying provisional filing date. Current patent law, for example, 35 U.S.C. § 132 requires that when any claim is rejected, the applicant shall be notified of the reasons "together with such information and references as may be useful in judging of the propriety of continuing the prosecution" of the application. The Examiner has not provided any information or references in support of the alleged correspondence between the '730 reference and its underlying provisional application. Moreover, according to MPEP § 706.02(f)(1) for a Section 102(e) rejection the Examiner may only rely upon a reference's claimed priority date "if the prior application(s) properly supports the subject matter used to make the rejection." *See also* MPEP § 706.02(a). The underlying provisional application of the '730 reference fails to properly support the priority claim as explained below for the portions relied upon by the Examiner in the Section 102(e) rejection. The MPEP further states that "If a claim in the nonprovisional application is not adequately supported by the written description and drawing(s) (if any) of the provisional application (as in *New Railhead*), that claim in the nonprovisional application is not entitled to the benefit of the filing date of the provisional application." (emphasis in original) MPEP § 201.11. Without a showing of correspondence between the relied upon portions of the

'730 reference and its underlying provisional application, the effective filing date for the '730 reference is the nonprovisional filing date of August 20, 1999.

The Examiner's contention that the '730 reference's effective filing date is the filing date of the underlying provisional application is misplaced. Applicant obtained a copy of the '730 reference's underlying provisional application, serial number 60/097,336, and although no drawings were provided with the provisional application, a comparison of the provisional application's Brief Description of the Drawings to the relied upon '730 figures establishes that the provisional application failed to include the relied upon figures. Although the Examiner has access to such provisional documents Applicant has attached pages 47-50, the Brief Description of the Drawings section, of the '730 underlying provisional application. Based upon this absence of the relied upon figures in the underlying provisional filing, it should be clear that the '730 reference is not a continuation or a straight conversion of the underlying provisional application.

Rather, the '730 reference's claim to benefit from the underlying provisional application's filing date is an example of the classic problem addressed by deputy commissioner Stephen G. Kunin in his publication notice entitled, "Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. §§ 119(e), 120, 121 and 365(c)" dated February 24, 2003. This notice evidences that the USPTO precludes the presumption that an applicant is entitled to an underlying provisional priority date without "specifying a relationship between each of the applications," such as being a continuation or a continuation-in-part. By failing to specify the relationship, deputy commissioner Stephen G. Kunin explains that the patent office has insubstantial information to determine whether there should be entitlement to the underlying provisional filing date.

The relied upon portions of the '730 reference (figures 13A and 13B and related embodiments) are not supported by the provisional application to which benefit was claimed. Therefore, for purposes of the instant Section 102(e) rejection, the effective filing date of the '730 reference should be the filing date of the '730 reference, August 20, 1999, which does not predate the instant application. Applicant respectfully submits that the relied upon portions of the '730 reference are not prior art with respect to the instant application and the rejection is improper. Accordingly Applicant requests that the rejection be withdrawn.

In view of the remarks above, Applicant believes that the rejection has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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By: 

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Encl.: 1) pages 47-50 of Prov. Serial No. 60/097,336  
2) copy of Prov. Serial No. 60/097,336  
3) USPTO notice "Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. §§ 119(e), 120, 121 and 365(c)"